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Dated: August 14, 2006

Signature

Lawrence E. Russ
(Lawrence E. Russ)

Docket No.: SONYJP 3.0-106
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Patent Application of:
Toshiro Ozawa

Application No.: 09/521,176

Group Art Unit: 2611

Filed: March 8, 2000

Examiner: D. D.
Saltarelli

For: PROGRAM DISTRIBUTION SYSTEM,
METHOD OF PROGRAM DISTRIBUTION,
TRANSMITTER AND RECEIVER

APPELLANT'S REPLY BRIEF ON APPEAL

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The present Reply Brief is responsive to the Examiner's Answer mailed June 12, 2006.

STATUS OF CLAIMS

Claims 1-3, 6-13, 16-23, 26-32, 35-38 and 40-49 are pending in the present application. All of claims 1-3, 6-13, 16-23, 26-32, 35-38 and 40-49 are rejected, and all of claims 1-3, 6-13, 16-23, 26-32, 35-38, and 40-49 are the subject of the present appeal.

GROUNDS OF REJECTION IN VIEW OF THE EXAMINER'S ANSWER

In the Examiner's Answer, the Examiner indicated that the following rejections remain:

(1) Claims 1, 3, 11, 13, 21, 23, 31, 32, 37, and 38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Dunn* (U.S. Patent No. 5,721,829) in view of *Abecassis* (U.S. Patent Application Publication No. 2001/0041053), *Sartain* (U.S. Patent No. 5,914,712), *Venkatraman* (U.S. Patent No. 6,477,647), and *Hylton* (U.S. Patent No. 5,613,190).

(2) Claims 2, 6-8, 12, 16-18, 22, 26-28, 35 and 40 were rejected under 35 U.S.C. § 103 as being unpatentable over *Dunn*, *Abecassis*, *Sartain*, *Venkatraman*, and *Hylton* as applied to claims 1, 11 and 21 and further in view of *Yurt* (U.S. Patent No. 5,550,863).

(3) Claims 9, 19, 29, 36 and 41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Dunn*, *Abecassis*, *Sartain*, *Venkatraman*, and *Hylton* as applied to claims 1, 11, and 21 and further in view of *Lawler* (U.S. Patent No. 5,805,763).

(4) Claims 10, 20, 30, 43, 45, and 47 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Dunn*, *Abecassis*, *Sartain*, *Venkatraman*, *Hylton*, and *Yurt* as applied to claims 6, 16, and 26 and further in view of *Lawler*.

(5) Claims 42, 44, 46, 48 and 49 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Dunn*, *Abecassis*, *Sartain*, *Venkatraman*, *Hylton*, and *Lawler* as applied to claims 9, 19, 29, 36, and 41 and further in view of *Yurt*.

ARGUMENT

In the Examiner's Answer, the Examiner provided an explanation to the above rejections and a response to the applicant's arguments presented in the Appellant's Brief on Appeal submitted on April 27, 2006. The following comments are presented in response thereto.

I. Neither Dunn Nor Sartain Nor Any Of The Other Cited References, Whether Taken Alone or In Combination, Discloses or Suggests "A Distribution E-mail Message . . . That Is Addressed To Said Distribution Controller of Said Transmitter. . ."

Claim 1 clearly calls for:

 said receiver being operable to accept a user request for a desired program, the user request being in a free style text format, to convert the user request into a distribution request e-mail message that includes the user request and that is addressed to said distribution controller of said transmitter, and to send the distribution request e-mail message to said transmitter;

and claim 1 further calls for:

said distribution controller being operable to receive the distribution request e-mail message addressed to said distribution controller, to determine whether the requested program is one of the stored plurality of distributable programs, to transmit an answer e-mail message to said receiver in response to the distribution request e-mail message, the answer e-mail message including a notice of correspondence and including supplemental information when the requested program is one of the stored plurality of distributable programs, the supplemental information including cryptanalytic information for decrypting the program, and to read out the requested program from said distributable program storing unit when the requested program is one of the stored plurality of distributable programs[.]

(Emphasis added.)

The other independent claims include similar limitations. As pointed out in Appellant's Brief on Appeal and in the

responses to the Office Actions, none of the references cited by the Examiner, whether taken alone or in combination, discloses or suggests a distribution request e-mail message that is addressed to said distribution controller of said transmitter.

Nevertheless, the Examiner persists in contending that the combination of *Dunn* (U.S. Patent No. 5,721,829) and *Sartain* (U.S. Patent No. 5,914,712) suggests the distribution request e-mail message as set out in the claims, and in the Examiner's Answer, the Examiner has presented various arguments that attempt to support his contention. The Examiner, however, continues to read more into the references than what is disclosed and more than what would be understood by a person of ordinary skill in the relevant art at the time of the invention.

Simply put, *Dunn* describes that (i) a user orders a video content program by activating an "order" button on a screen display which causes a message to be sent from a set-top box to a headend, and (ii) a video content playing unit, located at the headend, retrieves the program from a database, also located at the headend, and then controls transmission of the video program by the headend. (See Fig. 1, col.4 11.37-46, col.5 11.25-41.) As the Examiner acknowledges, *Dunn* does not disclose or suggest a distribution request e-mail message that includes the user request and that is addressed to a distribution controller of a transmitter.

Sartain describes (i) an office which receives user supplied video program selections via a gateway and which provides the video program to the user (see Fig. 5, col.8 11.58-61), (ii) that the office includes (a) a central database which contains all of the video programs along with a program which controls access to the stored video programs and (b) a command interface which allows the office to transmit the video programs (see Fig. 6, col.10 11.32-37, col.11 11.1-5), and (iii) that subscriber selections of the video programs are

entered (a) by telephone using interactive-voice response, (b) using a set-top box and a remote control, (c) by accessing a promotional telephone number, or (d) over the Internet using "an accounting service [located] within the internet [which] is provided. . . through an e-mail address. . . [and which] requests the selected video program identification number along with a credit card number" (see col.9 11.42-46 and 60-67, col.10 11.1-2, 8-11, and 15-22). Therefore, *Sartain* merely discloses that (i) subscriber requests for video programs are sent using an e-mail message addressed to the accounting service, (ii) the accounting service then sends the requests over the Internet to the office, (iii) the central database at the office reads out the selected video programs, and (iv) the office then sends the selected video program for delivery to the subscriber. There is no indication in *Sartain* as to whether the accounting service communicates with the office by e-mail, nor does *Sartain* provide such a suggestion. *Sartain* therefore does not disclose or suggest a request e-mail message that is addressed to the office (which provides the selected programs), does not disclose or suggest a request e-mail message that is addressed to the command interface of the office (which allows the office to send the video programs), and does not disclose or suggest a request e-mail message that is addressed to the central database at the office (which reads out the selected video programs). Hence, *Sartain* does not disclose or suggest that an e-mail message is addressed to any element that could be considered a distribution controller.

Notwithstanding the absence of any disclosure or suggestion in the references of a distribution request e-mail message that is addressed to a distribution controller of a transmitter, the Examiner continues to contend that such a suggestion is present and incorrectly asserts that:

.... there are discrepancies between the factual assumptions upon which appellant relies when addressing the *Sartain* reference and the subject matter actually being claimed. When appellant states that *Sartain* discloses addressing e-mail requests to an accounting service rather than the office that sends the selected programs to the subscriber's television, one could very well argue that appellant's own disclosure teaches addressing distribution requests to the VOD controller 15 which processes user requests rather than [to the] video server 12 which actually. . . send[s] the selected programs to the subscriber's television.

(Examiner's Answer, p. 20 11.12-21 (emphasis added).) However, the Examiner's argument is incorrect. The specification describes, e.g., that ". . . the VOD controller 15 provided in the transmitter 10 receives the distribution request mail Ereq. . ." and that ". . .the VOD controller 15 of the transmitter 10 transmits the program described in the answer mail Eans to the multiplexer 13 as the bit stream S12 by controlling the video server 12. . . multiplexes the bit stream S12 on the broadcast wave S10, and then transmits it." (See ¶¶ [0035] and [0043], (emphasis added).) Similarly, Claim 1 recites that "said distribution controller being operable to receive the distribution request e-mail message addressed to said distribution controller. . . and to read out the requested program from said distributable program storing unit. . ." and further recites "a distributor operable to distribute the requested program to said receiver." (Emphasis added.) By contrast, as pointed out above, *Sartain* neither discloses nor suggests addressing such e-mail requests to the central database of the office which controls access to the video programs, and *Sartain* neither discloses nor suggests addressing e-mail requests to the office. Thus, there is no discrepancy between the above description of *Sartain*, the claims, and the specification of the present application.

The Examiner also incorrectly reads one of Appellant's arguments in the Brief on Appeal. The Examiner asserts that "Appellant supports this position by. . . then stating that the external request gateway to which the e-mail is addressed does not provide video programming. . ." (Examiner's Answer, pg. 19 11.5-10). Appellant, however, was merely addressing the Examiner's contention that the address of the e-mail request is the external request gateway, and Appellant responded based on this assumption. (Appeal Brief, p. 7, 1.38 to p. 8, 1.3 and p. 8, 11.27-30). In actuality, *Sartain* does not disclose or suggest that the e-mail request is addressed to the external request gateway for the reasons set out above. The Examiner's subsequent reasoning (Examiner's Answer, p. 20, 1.21 to p. 21 1.12) is thus based on this erroneous reading of Appellant's argument and is incorrect.

The Examiner also continues to wrongly argue that even if the references are combined in the manner asserted by the Examiner, the asserted combination would meet all of the claimed limitations. (Examiner's Answer, p. 22 11.14-17 and p. 23 11.6-8). Actually, the Examiner's asserted combination would not disclose or suggest a distribution request e-mail message that includes the user request and that is addressed to the distribution controller of the transmitter. As described above, *Sartain* discloses an e-mail message addressed to an accounting service. *Sartain* does not disclose or suggest that the accounting service operates as a distribution controller and does not disclose or suggest that an accounting service communicates by e-mail with a distribution controller, and thus *Sartain* does not disclose or suggest an e-mail message addressed to a distribution controller. *Dunn*, as acknowledged by the Examiner, likewise does not disclose or suggest an e-mail message addressed to a distribution controller. Clearly, if neither *Sartain* nor *Dunn*, nor any of the other references cited

by the Examiner, discloses or suggests an e-mail message addressed to a distribution controller, the asserted combination cannot disclose or suggest an e-mail message addressed to a distribution controller of a transmitter.

Additionally, the asserted combination of Sartain and Dunn would not provide any suggestion to the ordinarily practitioner to replace the message sent from the settop box to the headend, as described by Dunn, with an e-mail message addressed to the headend. Sartain only teaches an e-mail message addressed to an accounting service and neither discloses nor suggests an e-mail message that is addressed elsewhere. Hence, there is no disclosure or suggestion for an e-mail message addressed to a headend. It follows that none of the cited references, whether taken alone or in combination, discloses or suggests an e-mail message addressed to a distribution controller of a transmitter.

Nevertheless, the Examiner incorrectly argues that appellant is arguing against the references individually. (Examiner's Answer, p. 23 11.17-19). Appellant, however, merely describes how both and Sartain and Dunn have the same deficiencies and how neither Sartain nor Dunn, whether taken alone or in combination, provides any suggestion as to how to remedy these deficiencies.

II. A Person of Ordinary Skill in the Relevant Art Would Not Look To Combine the Teachings of Venkatraman With Those of Dunn, Abecassis, Sartain, and Hylton.

Venkatraman specifically recites in the "Field of the Invention":

The present invention relates to the field of confirming trade transactions, and more particularly, to a system and method for confirming trade transactions by transmitting secure electronic envelopes containing trade confirmations via the Internet and/or private network to a customer's e-mail address.

(Col.1 ll.7-11, (emphasis added), see also Abstract 1.1-3.) By contrast, *Dunn* defines as its "Techinical Field":

This invention relates to interactive entertainment network systems, such as interactive television (ITV) systems, and to methods for operating such interactive entertainment network systems

(Col.1 ll.10-13, (emphasis added)), and *Sartain* recites:

The present invention relates generally to a method of displaying subscriber selected video information on a television.

(Col.1 ll.4-6, (emphasis added)). Clearly, *Venkatraman* is directed to the field of confirming trade transactions whereas *Dunn* and *Sartain* are each directed to a different field of endeavor.

The Examiner nevertheless contends that *Venkatraman* and the asserted combination of *Dunn* and *Sartain* are analogous art because each "describes a system wherein electronic transactions are carried out over an Internet medium" (Examiner's Answer, p. 26 ll.4-10), notwithstanding (1) the above-recited differences in the field of endeavors, (2) that *Venkatraman* uses a web page as an "Internet medium" whereas the "Internet medium" in the asserted combination of *Dunn* and *Sartain* is purportedly e-mail, and (3) the electronic transaction in *Venkatraman* is a completed trade whereas the electronic transaction in the asserted combination of *Dunn* and *Sartain* is a request for distribution of a video program. The Examiner thus attempts to group together references relating to different fields of endeavor as "analogous art." The Examiner attempts to define this purported grouping of references as being directed to "electronic transactions carried out over an Internet medium" even though almost every patent or printed publication directed to the Internet carries out some form of "electronic transaction." (A search of the patent full-text and full-image database, <http://www.uspto.gov./patft/index.html>, shows nearly

14,000 U.S. patents include the terms "Internet" and "transaction" and more than 17,000 published U.S. parent applications which also include both these terms.) Clearly, the Examiner's extremely broad view of what constitutes a common field of endeavor is incorrect, and it follows that *Venkatraman* is not directed to the same field of endeavor as *Dunn* and *Sartain*.

CONCLUSION

For all of the reasons set forth in Appellants' Appeal Brief and in this Reply Brief, the rejections of claims 1-3, 6-13, 16-23, 26-32, 35-38, and 40-49 should be reversed.

If there are any additional charges in connection with this brief, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: August 14, 2006

Respectfully submitted,

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